

### **REMARKS**

The Office Action dated September 3, 2003 has been received and carefully studied.

A Request for Continued Examination accompanies this amendment.

The Examiner objects to claim 13 due to a typographical error. By the accompanying amendment, claim 13 has been corrected.

The Examiner rejects claims 1-7 and 13 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner states that the scope of the claims is unclear, since the preamble of the claims recites a fastening tool yet the claims recite details of the fastener. By the accompanying amendment, the preamble of the claims has been amended to recite that the combination of a tool and fasteners. It is believed that the amendment overcomes the rejection.

The Examiner rejects claims 1-7 and 13 under 35 U.S.C. §102(b) as being anticipated by Dennis, U.S. Patent No. 5,178,903. However, U.S. Patent No. 5,178,903 is not to Dennis, but rather to Lat et al. The undersigned telephoned the Examiner to determine what the intended rejection was. The Examiner stated that the rejection was over Dennis, U.S. Patent No. 6,082,604.

The basis of the Examiner's rejection is that the details of the fastener in the claims are not given patentable weight, since they are not positively claimed. It is believed that this rejection is overcome by the foregoing amendment to the preamble, making it clear that the fastener and the tool are being claimed. Dennis does not disclose a tool and coated fastener combination.

The Examiner rejects claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over Dennis '604 in view of Kish '373 and further in view of Lat '903. The Examiner admits that Dennis does not disclose a dielectric coating coated to the bight portion and the pair of legs forming an insulated staple, or a uniform coating, and cites Kish and Lat et al. as teaching these features. Kish is cited for its disclosure of a dielectric coating on the bight and pair of legs, and Lat et al. is cited for its disclosure of a uniformly coated staple.

By the accompanying amendment, claim 8 has been amended to recite that the dielectric coating is uniformly coated on the staple body prior to formation into a bight portion

and a pair of legs. Support for the amendment can be found at page 8, second line from the bottom, to page 9, line 3, and at page 9, first full paragraph.

As stated previously and as admitted by the Examiner, Dennis does not disclose a dielectric coating coated to the bight portion and pair of legs of a staple.

Kish et al. '373 disclose a coated fastener wherein the coating is free of solvent emissions when applied and during curing. Kish et al. do not disclose that the coating is uniformly coated on the staple body to form an integral unitary structure as recited in the instant claims.

The Examiner cites Lat et al. '903 for its disclosure of a uniformly coated staple. However, Lat et al. do not disclose that the coating is uniform. Indeed, Lat et al. teach that the coating can be applied when the staples are collated:

“The coated staple 30 may be one of a series (not shown) of similar staples that are collated. The outer, thermoplastic, predominantly aliphatic polyurethane coating upon each of such staples including the coated staple 30 may be advantageously used to collate such staples by being applied to such staples after such staples have been placed in a series, that is, in side-to-side relationship with respect to one another.”

Column 6, lines 26-33. Thus, the areas wherein adjacent staples touch one another will not be coated, and a uniform coating is not achieved. Also, Applicant respectfully submits that a coating applied in this fashion will not inherently result in a unitary structure of staple and coating, as claimed in the present invention.


Moreover, Lat et al. differ from the present invention and Kish et al. in that the coating is applied after the staple is formed. Applying a coating to a straight, elongated wire as in Kish et al. is very different from applying a coating to a bent wire in the form of a staple as in Lat et al., especially when the staple and the coating form a unitary, uniformly coated structure, not used in adhering one staple to the other (as claimed in Lat et al.). Staples once formed and coated must subsequently be oriented and presented for adhesion to one another. This process is time consuming and expensive, and requires expensive orienting equipment. Applicants respectfully submit that one skilled in the art therefore would not be motivated to

apply any of the teachings of Lat et al. to Kish et al. in view of the above. Moreover, even were such motivation present, the instant invention as now claimed would not be arrived at, as a coating applied prior to staple formation to create an integral unitary structure would not be uniform, and is not suggested by the combination of cited references.

New claims 14-15 have been added to further define the invention.

Reconsideration and allowance are respectfully requested in view of the foregoing.

Respectfully submitted,

  
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